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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/782,735	02/19/2004	Gian-Carlo Covino	34064/US	3411								
7590 David E. Bruhn, Esq. DORSEY & WHITNEY LLP Intellectual Property Department 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402-1498		03/16/2010	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">MENDEZ, MANUEL A</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td colspan="2">3763</td></tr></table>		EXAMINER		MENDEZ, MANUEL A		ART UNIT	PAPER NUMBER	3763	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/782,735

**Applicant(s)**

COVINO ET AL.

**Examiner**

Manuel A. Mendez

**Art Unit**

3763

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 6-11 and 21-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 5** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "can not be elastically deformed" is considered vague since it does not disclose the particulars of the invention. Correction is respectfully requested.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

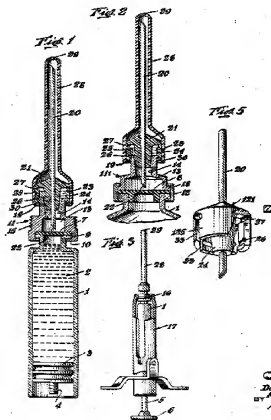
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-5, 12, and 16** are rejected under 35 U.S.C. 102(e) as being anticipated by **Ashkenaz et al.** (US 2,828,743; hereafter Ashkenaz).



The cited patent discloses a fixing device for injection needles, for pushing onto a thread of an injection apparatus, wherein said fixing device is formed as a cap comprising an open end and a closed end which holds a needle perpendicularly in the

middle of the fixing device, and a surface area of the fixing device is slightly spring-elastic in its circumference and comprises at least three cams directed to said thread, said cams perpendicularly engaging with flights of the thread when said cap is pushed onto the thread, wherein each cam comprises at least one notch arranged parallel to the surface circumference.

In relation to **claims 2 and 18**, figure 5 shows a cap wherein each cam has two tips, one tip below number 26 and the other tip below number 27. In relation to **claims 3, 16, 17, and 19**, figure 5 shows cams having three points of contact wherein the points of contact can be in different planes. Notably, as the needle is introduced into the vial, the cams that are mounted in skirts (125) will move laterally into different planes. In relation to **claim 4**, figure 5 shows the distance between the tips is approximately equal to the height of the flight. In relation to **claims 5 and 20**, figure 5 shows three skirts (125) acting as springs. In relation to **claim 12**, figures 1, 2, and 5 show an injection apparatus comprising a storage container wherein a needle penetrates into the storage container when the cap is pushed onto the thread of the injection apparatus.

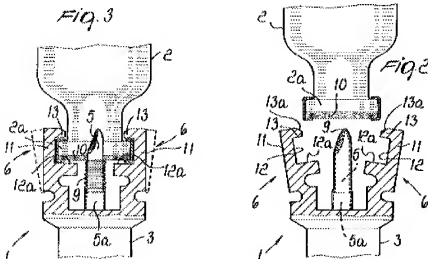
### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

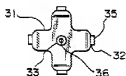
**Claims 13-15 and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ashkenaz** in view of **Azzolini** (US 6,575,955) or **Uchida** (US 5,445,631).

The Ashkenaz patent does not disclose a cap having at least five spring elements. However, designing an injection apparatus having multiple spring elements would have been considered conventional in the art as evidenced by the teachings of Azzolini (US 6,575,955) or Uchida (US 5,445,631).

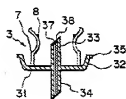


In relation to claim 13, figures 2 and 3 above, the Azzolini patent shows an infusion system having two spring elements.

*Fig. 6*



*Fig. 7*



Furthermore, the Uchida patent, in figures 6 and 7 above, shows a design having four spring elements. Accordingly, based on the evidence provided above, factually it can be concluded that spring elements are well known in the art and can be duplicated in various infusion system designs. Therefore, whether the infusion system is designed to have 2, 4, or 5 spring elements, such design would have been considered an obvious choice in the process of designing the infusion system.

In relation to **claims 14-15**, since caps and needles would have been considered conventional apparatuses at the time the invention was made, variations on the diameter of the of the cap or the gauge of the needle would have been considered obvious choices in the process of designing the infusion system.

#### ***Allowable Subject Matter***

**Claims 6-11 and 21-23** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel A. Mendez whose telephone number is 571-272-4962. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Manuel A. Mendez/

Primary Examiner, Art Unit 3763

Manuel A. Mendez  
Primary Examiner  
Art Unit 3763



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